

Remarks/Arguments:

Claims 1-27 were pending in this application. The applicants acknowledge the withdrawal of claim 19. The applicants respectfully traverse the withdrawal of claims 20-27. Claims 20-27 depend, either directly or indirectly, from claim 1 and not claim 19. Claim 1 was amended by the Response of June 13, 2003, which amendment is not indicated by the instant Office Action as containing a non-elected invention. Therefore, the applicants submit that dependent claims 20-27 are not directed to a non-elected invention. Support for claims 20-27 can be found in the specification, for example, on page 9 lines 1-5.

The applicants add claims 28-30. Support for claim 28 and 29 can be found at page 5, third full paragraph. Support for claim 30 can be found at page 12, first and final paragraphs and at page 13, second full paragraph. No new matter has been added.

Therefore, claims 1-18, and 20-30 are pending.

Objections to the Drawings:

The Office Action has objected to the drawings because the rectangular boxes/circles of FIGS 1 and 4 are not described in the specification. FIGS 1 and 4 contains reference numerals for all rectangular boxes/circles, which numerals are also described in the specification. The applicants respectfully ask for clarification as to which rectangular boxes/circles the objection is referring.

Office Action Rejections:

This Office Action rejects claims 1, 2 and 9-18 under 35 U.S.C. § 103(a) as being upantentable over Gardner et al. (U.S. 5,634,889) in view of Barak et al. (U.S. 6,494,852). The Office Action rejects claim 3 under 35 U.S.C. § 103(a) as being upantentable over Gardner et al. (U.S. 5,634,889) in view of Barak et al. (U.S. 6,494,852) and further in view of Raines et al. (U.S. 6,152,881). The Office

Action rejects claims 4-8 under 35 U.S.C. § 103(a) as being upantentable over Gardner et al. (U.S. 5,634,889) in view of Barak et al. (U.S. 6,494,852) and further in view of Haranda et al. (U.S. 4,9284701).

A. Non-obviousness of Claims 1 and 14

In forming all of the obvious rejections of claims 1-18, the Office Action cites the combination of Gardner et al. in view of Barak et al. The applicants respectfully submit that the Office Action has failed to set forth a *prima facie* case for obviousness in that the suggested combination of the Garner et al. reference with Barak et al. does not contain each and every limitation of the claimed invention.

Claim 1 as amended recites the limitations, "said device compris[es] a cuff adapted for application to an extremity for stimulating venous flow to the blood," and "said cuff [is pressurized] with an overpressure, compared to atmospheric pressure, in a range between 20 mm Hg and 100 mm Hg." Claim 14 as amended recites the limitations, "wherein the steps of applying said cuff to an extremity and intermittently pressurizing said cuff stimulates the return of venous blood flow," and "said cuff [is pressurized] with an overpressure, compared to atmospheric pressure, in a range between 20 mm Hg and 100 mm Hg."

Gardner et al. is directed at a medical appliance for intermittently pulsed compression of at least 75 mmHg of proximal joints to provide relief of pain and swelling at or near the joint. Abstract and Col. 3, lines 56-61. Gardner et al. does not fully understand why his invention works and admits that an "adequate theory has yet to fully explain the precise mechanics of pulsed compression at or near proximal joints." Col. 1, lines 60-65. Gardner et al. does state "the action is not one of intermittently pulsed compression of a reservoir of accumulating blood." Col. 1, lines, 59-60. Gardner et al. comes to this conclusion by comparing the invention contained in U.S. Patent No. 5,634,889 with his previous invention contained in U.S. Patent No. 4,614,180. Gardner states: "It is known from U.S. Patent No. 4,614,180 that impulse compression, locally applied as

intermittent pressure pulses in the plantar region of the foot, is an effective means of enhancing venous-return of blood to the heart." Col. 1, 13-16. In U.S. Patent No. 4,614,180, Gardner et al. however teaches to effectuate venous-return flow of blood to the heart, pressures of up to 200-220 mm Hg are required. Col. 7, line 31-35. A copy of Gardner et al. U.S. Patent No. 4,614,180 is included in the accompanying Information Disclosure statement. Therefore, neither the disclosures in Gardner's et al. U.S. Patent Nos. 5,634,889 or 4,614,180 teach stimulating the return of venous blood flow with an overpressure, compared to atmospheric pressure, in a range between 20 mm Hg and 100 mm Hg as claimed in claims 1 and 14. The combination of Barak et al. fails to fill this void.

B. Lack of Motivation to Combine

The Office Action at paragraph 7 indicates that Burns, U.S. Patent 3,552,381 is prior art made of record but not relied upon. Specifically, the Office Action states that Burns teaches blood pressure cuffs operating at 60 mm Hg.

The applicants respectfully submit that there is no motivation to combine Burns with Garner et al. in view of Barak et al. Such a combination would frustrate the purpose of the prior art references. Burns is directed toward a sphygmomanometric method and apparatus. Burns teaches a novel method for measuring blood pressure using a cuff that pressurizes to at least 60 mm Hg in synchronization with the repetition rate of the heart of a person. A person of ordinary skill in the art would not be motivated to combine the sphygmomanometer pressure to a device that is used to stimulate the return of venous blood flow by pulsed compression of accumulating reservoir of blood.

C. Certain Subject Matter Cited in U.S. Patent No. 6,494,852 to Barak et al. Does Not Predate the Inventive Date of the Instant Application

The applicants would like to make the following of record. U.S. Patent No. 6,494,852 ("the '852 patent") to Barak et al. is cited by the Office Action, in combination with other references, as rendering the instant claims obvious. Specifically, in forming the obvious rejection, the Office Action argues that the '852 patent discloses at FIG 1 and at col. 2, lines 8-31, a pneumatic compression using a miniature pressure generator secured to clothing, a belt for the purpose of enabling the patient to gain uninterrupted compression treatments while enjoying freedom of movement.

The '852 patent has a filing date of October 7, 1999. The '852 patent was filed as a continuation-in-part application and claims priority to U.S. Patent 6,478,757 ("the '757 patent"), also issued to Barak et al. and filed on March 11, 1998. By definition, a continuation-in-part (CIP) is an application filed during the lifetime of an earlier nonprovisional application, repeating some substantial portion or all of the earlier nonprovisional application and *adding matter not disclosed* in the said earlier nonprovisional application. (*In re Klein*, 1930 C.D. 2, 393 O.G. 519 (Comm'r Pat. 1930)). Thus, if a patent application is filed and ultimately issues as a CIP of an earlier U.S. application, any claims or subject matter in the specification in the later filed CIP not supported by the specification or claims of the earlier filed parent application will have an effective filing date equal to the filing date of the CIP. See MPEP § 706.02.

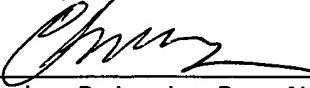
A comparison of the CIP '852 patent with its parent '757 patent reveals that the disclosure cited by the Office Action, namely col. 2, lines 8-31, is not contained in the earlier filed '757 patent. Therefore, the disclosure at col. 2, lines 8-31 of the '852 patent is only afforded the filing date of October 7, 1999. As a result, the subject matter contained at col. 2, lines 8-31 does not qualify as prior art.

Conclusion

The applicants respectfully request consideration of the restriction of claims 20-27 in view of the above arguments. With regards to the Office Action

rejections of claims 1-18 and in view of claims 20-30, the applicants submit that the combination of Garner et al. with Barak et al. fails to teach each and every limitations found in the independent claims, namely the limitations of stimulating the return of venous blood flow in a range between 20 mm Hg and 100 mm Hg. Neither the references cited nor the prior art relied upon, renders the instant claims obvious. Accordingly, the applicants respectfully submit claims 1-18 and 20-30 are in a condition for allowance and request early notification to this effect.

Respectfully submitted,


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